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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|-----------------------|----------------------------|------------------------|
| 10/798,444  | 03/12/2004  | Dwight Allen Merriman | 11032-3069                 | 5265                   |
| 23838 7590 07/12/2007<br>KENYON & KENYON LLP<br>1500 K STREET N.W.<br>SUITE 700<br>WASHINGTON, DC 20005 |             |                       | EXAMINER<br>MYHRE, JAMES W |                        |
|   |             |                       | ART UNIT<br>3622           | PAPER NUMBER           |
|   |             |                       | MAIL DATE<br>07/12/2007    | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/798,444 | <b>Applicant(s)</b><br>MERRIMAN ET AL. |  |
|                              | <b>Examiner</b><br>James W. Myhre    | <b>Art Unit</b><br>3622                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/17/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This Office Action is in response to the initial filing of March 12, 2004. Claims 1-6 are currently pending and have been considered below.

### ***Information Disclosure Statement***

2. The information disclosure statement filed October 17, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The US and foreign patents on pages 1-6 of the Information Disclosure Statement have been considered; however, the Non-Patent Literature cited on pages 7-18 are not readily available to the Examiner (as the Applicant has indicated, they are scattered throughout 10 other applications) and have not been examined.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/798,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application pertains to the method steps for implementing the apparatus in claim 1 of the present application, less the final step of generate a report about the placement of the advertisements. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to either include or exclude report generation as part of the method or apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 16, and 19-22 of copending Application No. 10/798,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application

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pertains to the method steps for implementing the apparatus in claim 1 of the present application, less the final step of generate a report about the placement of the advertisements. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to either include or exclude report generation as part of the method or apparatus. Additionally, claims 19-22 of the copending application are the method steps corresponding to the apparatus in claims 2-5 of the present application and claim 16 of the copending application is the method steps corresponding to claim 6 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 16, and 19-22 of copending Application No. 10/937,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application pertains to the method steps for implementing the apparatus in claim 1 of the present application, less the final step of generate a report about the placement of the advertisements. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to either include or exclude report generation as part of the method or apparatus. Additionally, claims 19-22 of the copending application are the method steps corresponding to the apparatus in claims 2-5 of the present

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application and claim 16 of the copending application is the method steps corresponding to claim 6 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1–6 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerace (5,848,396).

Claim 1: Gerace discloses an apparatus for advertising, comprising:

- a. a processor, memory, and database (column 14, lines 4-35;
- b. collecting information based upon a plurality of advertisement requests sent from a user (column 2, lines 16-18 and column 14, lines 4-35);
- c. selecting an advertisement based upon the collected information (column 14, lines 4-35);

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d. basing the advertisement request on a link on a content request from said user (column 14, lines 4-35);

e. updating the available advertisements (column 14, lines 4-35 and column 17, lines 10-17); and

f. generating a report about the placement of advertisements (column 3, lines 15-19 and column 12, lines 57-63).

Claim 2: Gerace discloses an apparatus for advertising as in Claim 1 above, and further discloses sending the selected advertisement to the said user for display (column 14, lines 4-35).

Claim 3: Gerace discloses an apparatus for advertising as in Claim 2 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 14, lines 4-35 and column 17, lines 10-17).

Claim 4: Gerace discloses an apparatus for advertising as in Claim 3 above, and further discloses sending a network address (URL) to the user in response to the click-through request (column 14, lines 50-59).

Claim 5: Gerace discloses an apparatus for advertising as in Claim 3 above, and further discloses storing information about a prior click-through from said user (column 6, lines 58-60 and column 14, lines 4-35).

Claim 6: Gerace discloses an apparatus for advertising as in Claim 1 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 17, lines 38-52).

9. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al (5,933,811).

Claim 1: Angles discloses an apparatus for advertising, comprising:

- a. a processor, memory, and database (column 14, lines 4-35;
- b. collecting information based upon a plurality of advertisement requests sent from a user (column 13, line 55 – column 14, line 15);
- c. selecting an advertisement based upon the collected information (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26);
- d. basing the advertisement request on a link on a content request from said user (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26);
- e. updating the available advertisements (column 18, line 35 – column 20, line 26); and
- f. generating a report about the placement of advertisements (column 16, lines 8-15).



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Claim 2: Angles discloses an apparatus for advertising as in Claim 1 above, and further discloses sending the selected advertisement to the said user for display (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26).

Claim 3: Angles discloses an apparatus for advertising as in Claim 2 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26).

Claim 4: Angles discloses an apparatus for advertising as in Claim 3 above, and further discloses sending a network address (URL) to the user in response to the click-through request (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26).

Claim 5: Angles discloses an apparatus for advertising as in Claim 3 above, and further discloses storing information about a prior click-through from said user (column 2, line 59 – column 3, line 17 and column 18, line 35 – column 20, line 26).

Claim 6: Angles discloses an apparatus for advertising as in Claim 1 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 13, lines 2-7 and column 18, line 35 – column 20, line 26).

**Conclusion**

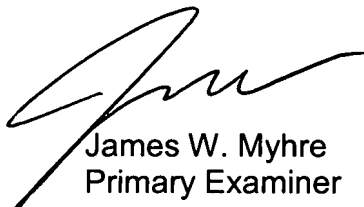
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWM  
June 25, 2007



James W. Myhre  
Primary Examiner